

34. The teleconferencing system of Claim 33, further comprising:

(a) a multimedia mail system, in communication with the in communication with the storage medium and configured to allow a sending participant to send the multimedia document to a receiving participant at a venue selected from the group consisting of:

- (i) in real time at a location removed from the preparing participant;
- (ii) at a different time at the same location as the document was prepared; and
- (iii) at a different time at a location removed from the preparing participant.

C2 end
¹¹ 35. The teleconferencing system of Claim ¹⁰34, wherein the multimedia mail system is in communication with a graphical animations originator device which can generate, save and replay animated graphical images that can be included in the multimedia mail document.

¹² 36. The teleconferencing system of Claim ¹¹35, further comprising:
(a) a message marker that can be used to mark a portion of the multimedia document, wherein the marked portion can be selectively displayed by the receiving participant when the multimedia document is reproduced.

REMARKS

Various stylistic amendments have been made to Claims 2-28. For example, among others, the word "said" has been replaced with the word "the" in all the claims. Additionally, the word "for" has been replaced with other language to emphasize the non-means-plus-function nature of the elements in the claims. Applicants aver that these changes were not made to distinguish prior art. Eight new claims, Claims 29-36, have also been added.

In view of the above amendments and the arguments presented below, Applicants respectfully request reconsideration and further examination of this application.

Claims Rejections*Rejections Under 35 U.S.C. § 102(b)*

In the May 20, 1997 Office Action, the Examiner rejects Claims 2, 3, 5-7, 15-16, 18-19, 22-23 and 28 under 35 U.S.C. § 102(b) as being anticipated by the Etherphone system as disclosed by Rangan "Software Architecture for Integration of Video Services in the Etherphone System". In particular, the Examiner states on pages 2-4 of the Office Action:

As per claim 2, Rangan teaches a teleconferencing system essentially as claimed, comprising: a teleconferencing manager [p.1396 fig.1 CM server], at least one of said participant is a multimedia service [p.1396 col.1 lines 32-36 'video file server'] for providing video signal at another workstation [video access] and receiving video of another participant [store proceedings of conference].

As per claim 3, Rangan teaches a teleconferencing system essentially as claimed, comprising:

data conference capture tools and annotation tools [p.1396 col.1 lines 39-45 "Tiogavision"].

Rangan suggested providing a multimedia mail system [p.1402 col.1 last paragraph] with captured and annotated data. It is inherent that the multimedia mail can be collaborated in real time at different location, at different time at same location, or at different time and different location.

As per claim 5, it is rejected under similar rationale as for claim 3 above.

As per claim 6, it is apparent from p.1401 col.2 that AV capture include AV images of the preparing participant and AV image of other participants.

As per claim 7, Rangan teaches message marker [p.1402 col.1 2nd paragraph "annotation icon"].

As per claim 15, Rangan teaches depository being operable to receive and store multimedia mail messages under direction of the preparing participant [p.1401 "Video File Server"]

As per claim 16, Rangan teaches audio, video and data components [p.1402 col.1 first paragraph].

As per claim 18, it is rejected under similar rationale as for claim 28 below.

As per claim 19, Rangan teaches [p.1402 col.1 2nd paragraph] AV signal carried in either analog [video rope] or digital signal [digitized video frame].

As per claim 22, it is rejected under similar rationale as for claim 5 above.

As per claim 23, Rangan teaches message marker [p.1402 col.1 2nd paragraph "annotation icon"].

As per claim 28, Rangan teaches a method of conducting teleconference, comprising the steps of:

carrying AV signal among the workstations [apparent from fig.1];

managing a videoconference [p.1397]; and

storing, as a multimedia mail message [multimedia document], AV signals generated at the workstation of a preparing participant [p.1401 col.2 lines 2-10]; and

recording AV signal during videoconferencing [p.1401 col.2 line 5 "participant can store parts of their conference"];

storing, as a multimedia mail message [col.1 p.1402 last paragraph], data and AV signal during the conference [p.1401 col.2 lines 2-10 "multimedia document"] and forwarding multimedia mail to a receiving participant [apparent function of an e-mail facility].

The M.P.E.P. provides that "[a] claim is anticipated only if each and every element as set

forth in the claim is found, either expressly or inherently described, in a single prior art reference."¹

Amended Claim 2 includes a "first network" over which a "data conference can be conducted." As per the Examiner's comment regarding claim 10, Rangan does not teach any data conferencing at all. For the Examiner's reference, data conferencing includes the interactive sharing of text, graphical images, documents, etc. images displayed on screens of different participants. Rangan, therefore, does not disclose a first network over which a data conference can be conducted and can not maintained as a § 102(b) reference. Consequently, the § 102(b) rejection of Claim 2 should be withdrawn.

Rangan does not teach every element of Claim 3. Element (a) of Claim 3 claims "*data conference capture tools*." (emphasis added). Rangan does not teach data conferencing. For this reason, Rangan cannot possibly teach use of data capture tools for use in a "data conference." Moreover, the Tiogavision system disclosed in Rangan, is a video document editor that permits editing of video documents stored on optical disks, does not perform "annotation" of "captured" data" during a "data conference." In other words, Tiogavision does not interwork with a data conference, as the claimed annotation tools do.

Additionally, Applicants disagree with the Examiner's assertion that the claimed multimedia mail system time/place venue variations, as recited in Claim 3, are "inherent." "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.'" (emphasis in original).² The

¹ M.P.E.P. § 2131 (Rev. 2, July 1996) (citing, *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed Cir. 1987)).

² M.P.E.P. § 2112 ¶1 (Rev. 2, July 1996) (citing, *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Examiner has provided no rationale or evidence that tends to show any inherency.

Besides, audio and video signals are temporal by nature, while data conferencing signals or asynchronous. Coordinating and storing these signals cannot be considered inherent from a reference that does not disclose data conferencing. Applicants, therefore, believe that the time/place venue variations are not inherent and respectfully request, from the Examiner, his reasons as to why he thinks they are.

For the reasons provided in the preceding two paragraphs, Applicants respectfully request that the § 102(b) rejection of Claim 3 based on Rangan be withdrawn.

The § 102(b) rejections of amended Claim 5, as it was rejected "under similar rationale as for claim 3," should likewise be withdrawn. Moreover, there is no teaching in Rangan that a stored multimedia mail message can be forwarded to another party. Instead, Rangan's optical disk storage system shows no possibility of "forwarding" a message to another participant. Accordingly, it cannot be said that Rangan anticipates, whether actually or inherently, the claimed invention.

Claims 6, 7, 15 and 16 depend on Claim 5. Consequently, as the § 102(b) rejection of Claim 5 is not sustainable, neither can the § 102(b) rejections of Claims 6, 7, 15 and 16. Therefore, these rejections should be withdrawn.

Because Claim 22 was rejected "under similar rationale as for claim 5," the remarks above in response to the § 102(b) rejection of Claim 5 also apply to the rejection of Claim 22. Accordingly, the § 102(b) rejection of Claim 22 should be withdrawn.

Amended Claim 28 includes the step of "managing a data conference." As described above, Rangan does not discuss data conferencing or a method of managing one. Thus, Rangan cannot be maintained as a § 102(b) reference. Consequently, the § 102(b) rejections of

Amended Claim 28 should be withdrawn. Because Claim 18 was rejected "under similar rationale as for claim 28," the remarks above in response to the § 102(b) rejection of Claim 28 also apply to the rejection of Claim 18. Accordingly, the § 102(b) rejection of Claim 18 should be withdrawn.

Claim 19 depends on Claim 18 and Claim 23 depends on Claim 22. Because the § 102(b) rejections of Claims 18 and 22 should be withdrawn, based on the foregoing remarks, so then, therefore, should the § 102(b) rejections of Claim 19 and 23.

Rejections Under 35 U.S.C. § 103(a)

On page 5 of the Office Action, the Examiner rejects Claim 4 under § 103(a) "as being unpatentable over the Etherphone system as disclosed by Rangan 'Software Architecture for Integration of Video Services in the Etherphone System'." In particular, the Examiner states:

As per claims 4, Rangan does not disclose graphical animation device for generating animated graphic images to be included in a multimedia message. It is well known in the art to have animation graphic images in multimedia document. The type of media included in a multimedia mail would have been a matter of design choice dependent on the preference of the user composing the mail message.

The M.P.E.P states that the "initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done."³ Furthermore, "to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested in the prior art."⁴

The Examiner has provided no suggestion of the desirability of doing what Claim 4 claims. Moreover, Applicants respectfully believe that the Examiner's statement that "it is well known in the art to have animation graphic images in multimedia document[s]" is nothing more than an unsubstantiated assertion. No references have been cited, and, in no way could

³ M.P.E.P. § 706.02(j), ¶3 (Rev. 2, July 1996).

⁴ M.P.E.P. § 2143.03 ¶1 (Rev. 2, July 1996) (citing, *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)).

such a bare assertion be construed as fulfilling the examiner's initial burden of presenting a *prima facie* case of obviousness.

Despite the Examiner's failure to present a *prima facie* case of obviousness, however, Claim 4 is nonobvious by virtue of its dependency on a nonobvious independent claim. The M.P.E.P. states that "[i]f an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious."⁵ Accordingly, as Claim 4 depends on Claim 3 (Claim 3 being a nonobvious independent claim), it follows that Claim 4 is nonobvious. For this reason and the reasons presented above, the § 103 rejection of Claim 4 is untenable. Applicants, therefore, respectfully request that the § 103 rejection be withdrawn.

On pages 5-7 of the Office Action, the Examiner rejects Claims 10-14, 17, 20-21, 25-27 under 35 U.S.C. § 103(a) as "being unpatentable over the Etherphone system as disclosed by Rangan 'Software Architecture for Integration of Video Services in the Etherphone System' and further in view of Maeno 'Distributed Desktop Conferencing System (MERMAID) Based on Group Communication Architecture'." In particular, the Examiner states:

As per claim 10, Rangan does not specifically disclose a data conference manager for managing data conference. Maeno disclose a teleconferencing integrating data and video conferencing. It would have been obvious for one of ordinary skill in the art to provide a data conference manager with Rangan's system because it would enable participants to view and process multimedia documents simultaneously with voice + video conferencing [Maeno p.0522 col.1 first paragraph].

It is apparent in the system as modified that the conference recorder would record audio, video and data during the conference.

As per claim 11, Maeno teaches data capture tool, annotating shared data [p.0522 col.1 last paragraph].

As per claims 12-13, Rangan teaches conference recorder [p.1401 "Video File Server"]. It is apparent that the mail system would have storage for multimedia document such that it can be retrieve by a participant and information can be transfer between the mail system, conference recorder, and the multimedia document [Rangan p.1402].

As per claim 14, Rangan teaches AV file system for storing and retrieving audio video images [p.1401 "Video File Server"].

As per claim 17, it is rejected under similar rationale as for claims 5+10 above.

As per claim 20, it is rejected under similar rationale as for claims 5+10 above. Maeno teaches data capture tool, annotating captured data [p.0522 col.1 last paragraph].

⁵ M.P.E.P. § 2143.03 ¶1 (Rev. 2, July 1996) (citing, *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)).

As per claims 21, the references do not disclose generating animated graphic images to be included in a multimedia message. It is well known in the art to have animation graphic images in multimedia document. The type of media included in a multimedia mail would have been a matter of design choice dependent on the preference of the user composing the mail message.

As per claim 25, Rangan teaches conference recorder [p.1401 "Video File Server"]. It is apparent that the mail system would have storage for multimedia document such that it can be retrieve by a participant and information can be transfer between the mail system, conference recorder, and the multimedia document [Rangan p.1402].

As per claim 26, Maeno teaches data capture tool, annotating shared data [p.0522 col.1 last paragraph].

As per claim 27, Rangan and Maeno teach storing and retrieving multimedia document [Rangan p.1401 col.2 lines 8-10, Maeno p.0522 col.1 last paragraph].

Claims 10-14 depend on Claim 5. Because Claim 5 is nonobvious, so too then are Claims 10-14 as depending on a nonobvious base claim (see footnote 5). Consequently, the § 103 rejections of Claims 10-14 should be withdrawn.

The Examiner rejected Claim 20 "under similar rationale as for claim 5+10 above." The remarks above, as they were presented in response to the § 102(b) rejection of Claim 5 (more particularly, with respect to Claim 3 from which the Examiner derived his § 102(b) rejection of Claim 5), consequently apply here. For those reasons the § 103 rejection of Claim 20 should be withdrawn.

Because Claim 21 depends on Claim 20 (a nonobvious base claim), the § 103 rejection of it cannot be sustained (see footnote 5). Therefore, the § 103 rejection of Claim 21 should be withdrawn.

Claims 25-27 depend on Claim 22 (an unobvious base claim). Consequently, the § 103 rejections of Claims 25-27 cannot be sustained (see footnote 5). Therefore, the § 103 rejections of Claims 25-27 should be withdrawn.

On page 8 of the Office Action the Examiner rejects Claims 8-9 and 24 under 35 U.S.C. § 103(a) "as being unpatentable over the Etherphone system as disclosed by Rangan "Software Architecture for Integration of Video Services in the Etherphone System" and further in view of Rosenbaum US patent 5,404,435." In particular, the Examiner states:

As per claims 8-9, Rangan does not teach tag searcher for searching defined tag in multimedia mail message. Rosenbaum teaches a multimedia document system with searchable tags to enable retrieval of the whole or portion of the multimedia document. Hence, it would have been obvious for one of ordinary skill in the art to combine the teaching of Rosenbaum with Rangan and thereby arrives at the claimed invention.

As per claim 24, it is rejected under similar rationale as for claim 8 above.

Claims 8-9 and Claim 24 depend on nonobvious base claims (i.e., Claims 5 and 22 respectively). Consequently, the § 103 rejections of Claims 8-9 and Claim 24 cannot be sustained (see footnote 5). Therefore, the § 103 rejections of Claims 8-9 and Claim 24 should be withdrawn.

CONCLUSION

For the reasons provided above, Applicants respectfully submit that amended Claims 2-28, and new Claims 29-36 are in a condition for allowance and allowance at an early date would be appreciated. Should the Examiner have any questions or comments, he is encouraged to call the undersigned to discuss the same so that any outstanding issues can be expeditiously resolved.

Respectfully submitted,



CRAIG A. OPPERMAN
Reg. No. 37,078

COOLEY GODWARD LLP
Five Palo Alto Square
3000 El Camino Real
Palo Alto, CA 94306-2155
Telephone: (415) 843-5000
Facsimile: (415) 857-0663